



## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Ken HIRUNUMA et al.

Group Art Unit : 2872

Appl. No. : 10/700,496

Examiner : PRITCHETT, J.

Filed : November 5, 2003

Confirmation No. : 6278

For : DIGITAL-CAMERA-PROVIDED BINOCULARS

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

U.S. Patent and Trademark Office  
Customer Window, Mail Stop AF  
Randolph Building  
401 Dulany Street  
Alexandria , VA 22314

Sir:

In response to the outstanding Final Official Action of October 18, 2005, in which a three month shortened statutory period for response was set to expire on January 18, 2006, and for which a Notice of Appeal is being concurrently filed, Applicants respectfully request a Pre-Appeal Brief Panel to review and withdraw the outstanding rejections set forth in the above-mentioned Final Official Action in view of the herein-contained remarks.

REMARKS

In the outstanding Official Action, each of claims 1-7 was rejected under 35 U.S.C. §102(e) as being anticipated by WU et al. (U.S. Patent Publication No. 2005/0018048). Independent claim 1 recites: *Digital-camera-provided binoculars, comprising: a digital camera that is able to capture an image of an object which is observed through optical systems of said binoculars; and a*

*microphone; wherein said microphone is provided on a bottom face of said binoculars.*

As described in Applicants' specification beginning, *inter alia*, page 2, line 1, known digital cameras and digital binoculars are often equipped with microphones on the object side or on the upper surface of the device, to better record the sounds of an object being observed. However, as noted in Applicants' Response filed on August 19, 2005 (all arguments made therein being expressly incorporated herein), the present invention is useful for bird-watching, and as such, a microphone located on a bottom surface, or underside, of the binoculars is positioned closer to the user's mouth so that the user need not amplify his/her voice to ensure sound recordation, which may otherwise (as with conventional digital camera-equipped binoculars) scare birds away.

In the outstanding Final Official Action, the Examiner asserts, in the final paragraph of page 2, that "WU discloses a digital camera provided binoculars . . . wherein the microphone is provided one [*sic*, "on"] a bottom face of the binoculars."<sup>1</sup> The Examiner attempts to support his position by further asserting that "Figure 1 shows the digital camera (2), which is also the microphone on a bottom face of the binoculars" and that "[t]he WU reference does not disclose whether this is the top or bottom face." The Examiner continues by indicating that he interprets WU "to allow the digital camera (2) to be located on either the top or the bottom face depending on the user's preference to actuate the buttons (22 and 23) with either an index finger or a thumb."

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<sup>1</sup> Applicants note that the newly-applied BOYS reference obliquely refers to a microphone (not shown) "mounted in a convenient location."

In Applicants' Response, Applicants asserted that Fig. 1 of WU shows the device in its intended upright position, and it is not reasonable to assume that a user would turn the WU device upside down to use it, any more than it would be for a user to turn a digital camera or a pair of binoculars upside down and use them. For example, when a digital imaging device is turned upside down, the "status indicators" (e.g., exposure setting, number of images remaining, etc.) viewed on the display will also be upside down.

Nevertheless, in the "Response to Arguments" section of the Final Official Action, the Examiner notes that "Fig. 4 of WU shows that the input module includes both the CCD sensor and the microphone, therefore the microphone would be within the structure labeled 2 in Fig. 1" and again maintains that it "does not appear to be unreasonable" to use the digital camera/binocular or WU in an upside down position. Lastly, the Examiner asserts that "if the Applicant's arguments were held to be persuasive any person who happened to pick up the WU binoculars upside down would be infringing on the applicant's patent."

Applicants again traverse the Examiner's rejection of the pending claims. Initially, contrary to the Examiner's assertion (and as noted in Applicants' previous Response), Applicants note that WU completely fails to disclose the location of the microphone in relation to the binoculars. For example, paragraphs [0021] and [0022] of WU (identified by the Examiner) merely note that image/audio signal compression and storage parts are located in the digital storage unit 2, shown on top of the binoculars in Fig. 1. Neither the specification nor the drawings of WU discloses the claimed location of the microphone, and an

anticipation cannot be based on teachings in a reference that are vague or based on conjecture. See *Datascope Corp. v. SMEC, Inc.*, 227 USPQ 838 (Fed.Cir. 1985). Further, it is well settled that an anticipation rejection cannot be predicated on an ambiguous reference. See *In re Turlay*, 304 F.2d 893, 134 USPQ 355 (CCPA 1962). Thus, Fig. 1 does not “show the digital camera (2), which is also the microphone on a bottom face of the binoculars.”

Secondly, Applicants again maintain that the broadest *reasonable* interpretation of WU is that the binoculars are intended to only be used in the upright position (in relation to a user’s face) as shown in Fig. 1. Since WU is silent as to the positional relationship of the binoculars of Fig. 1, it is reasonable to conclude that the binoculars are shown in its intended upright position (in relation to the user’s face). With respect to the Examiner’s assertion that “any person who happened to pick up the WU binoculars upside down would be infringing on the applicant’s patent,” Applicants note that mere assertions cannot change realities, and thus merely turning an object upside down does not make the bottom surface the top surface, and vice-versa. For example, if the Examiner were to turn the WU device around to take a self-portrait, the front end does not become the back end, and vice versa.<sup>2</sup>

Even if it could be considered reasonable to use the WU device in a position upside-down from Fig. 1, WU still does not teach or suggest that the microphone would be on the bottom surface. For example, Fig. 1 shows the imaging lens 21 on a *front* surface of the binoculars. Under the Examiner’s

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<sup>2</sup> Perhaps this point was best illustrated by a quote attributable to Abraham Lincoln during the Lincoln-Douglas debates of 1858. Lincoln posited “How many legs does a dog have if you call the tail a leg? Four. Calling a tail a leg doesn’t make it a leg.”

reading of WU (*i.e.*, that “the input module includes both the CCD and the microphone, therefore the microphone would be within the structure labeled 2”), then WU’s microphone would also be on the front surface of the WU binoculars, and as such, would still be on the front surface of the binoculars regardless of whether the device was used upside down or right side up.

### CONCLUSION

Accordingly, Applicants respectfully submit that the rejection of claim 1 is improper, at least because WU does not disclose or suggest, either explicitly or implicitly, at least the above-noted features of the combination recited in claim 1. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claim 1.

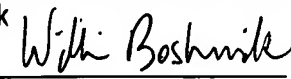
Applicants further submit that each of claims 2-7 (rejected under 35 U.S.C. § 102 or 103) are allowable at least for depending, directly or indirectly, from allowable independent claim 1, as well as for additional reasons related to their own recitations. In this regard, Applicant notes that WU does not disclose features of dependent claims at least as previously noted in Applicants’ Response submitted on August 19, 2005.

If there should be any questions about this application, the Examiner is invited to contact the undersigned at the telephone number listed below.

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